



PATTON PAINT COMPANY V. SUNSET PAINT CO.

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PATTON PAINT COMPANY (PITTSBURGH PLATE GLASS CO. SUBSTITUTED) V. SUNSET PAINT CO.

*Court of Appeals of the District of Columbia**June 4, 1923*~~TRADE-MARKS—OPPOSITION—“SUNSET” NOT CONFUSINGLY SIMILAR TO “SUN-PROOF” AS APPLIED TO PAINTS—APPEAL—AFFIRMAL~~

The word “Sunset” as a trade-mark for paints is not so similar to the registered trade-mark “Sun-Proof” as to warrant a denial of registration, inasmuch as it is a part of applicant’s name and hence serves to identify the latter’s goods; while the word “Sun-Proof” emphasizes the sun-resisting qualities of opposer’s products and the two marks as entireties are unlike in appearance, sound and meaning.

Appeal from a decision of the Commissioner of Patents in an opposition proceeding. Affirmed.

Clarence M. Brown, of Philadelphia, Pa., for appellant.

Watts T. Estabrook, of Washington, D. C., for appellee.

SMITH, J.: The Sunset Paint Company located in Los Angeles, California, filed on the 27th of January, 1920, an application in the Patent Office for the registration of the word “Sunset” as a trade-mark for its paints, varnishes and painters’ materials.

To that application the Patton Paint Company filed its opposition in December, 1920, and therein alleged that the word “Sun-Proof” and a conventionalized, pictorial representation of the sun, had been registered in the United States Patent Office in February, 1897, as the trade-mark of the James E. Patton Company and that that mark had been duly assigned to the opposer and had been continuously used by the opposer, its assignors and predecessors in business, ever since the year 1896; that the Patton Paint Company in July, 1915, registered in the Patent Office as a trade-mark for its goods another conventional representation of the sun known as the “Sun-Face and Rays,” which trade-mark had been continuously used by the opposer ever since the first of January, 1908; that the word “Sunset” sought to be registered as a trade-mark resembled the trade-marks of the Patton Paint Company and that the impressions conveyed by the words “Sunset” and “Sun-Proof,” ac-

accompanied by a pictorial representation of the sun, were so similar as to confuse and mislead the public with resulting damage to the Patton Paint Company.

To this opposition the Sunset Paint Company made answer denying that the trade-marks presented for registration were so similar to those of the Patton Paint Company that they would either mislead or confuse the public or damage the opposer.

Testimony was taken on the issue joined and the Examiner of Interferences held that the word "Sunset" sought to be registered was similar to the mark "Sun-Proof" of the opposer and therefore denied the application of the Sunset Paint Company.

On appeal to the Commissioner of Patents, the First Assistant Commissioner of Patents reversed the decision of the Examiner of Interferences and dismissed the opposition. From the decision of the First Assistant Commissioner the Patton Paint Company took this appeal and now contends that the Commissioner of Patents erred in finding that there was no such resemblance between the marks of the applicant and the opposer as would confuse and mislead the public.

In our opinion there is no such similarity between the marks as would warrant a denial of the application for registration of the word "Sunset." The Company seeking registration is the Sunset Paint Company and the word which it desires to register as its trade-mark conforms to the fanciful part of its name and therefore serves to identify the goods which it sells as those of the Sunset Paint Company. On the other hand, "Sun-Proof," the mark of the opposer, constitutes no part of the owner's name and conveys to the public the idea that paints, varnishes and painters' materials identified by it resist the sun's rays. In brief, one trade-mark indicates to the public the name of the dealer and the other calls attention to the sun-resisting qualities or properties of the goods to which it is applied. The marks have nothing in common except the first syllable and are entireties so unlike in appearance, sound and meaning that a purchaser would be exceedingly unwary who would mistake one for the other. The word "Sunset" may be so used in connection with a representation of the sun as to constitute

unfair competition, but in that event the opposer has an adequate remedy which opposition to registration does not afford, accomplishing as it does, if successful, nothing more than the shifting of the burden of proof. No right of property is concluded by registration of a mark and the parties affected are free to seek such relief as courts of law or equity may award. *William Rogers v. International Silver Company*, 30 Appls. D. C. 97, 105.

The decision appealed from is affirmed.

JAMES F. SMITH,

Judge of the U. S. Court of Customs Appeals, assigned by the Chief Justice of the United States, for service in the Court of Appeals of the District of Columbia.

CARLISLE TIRE CORPORATION V. LIGHTNING SALES CORPORATION

In the United States Patent Office

May 26, 1923

TRADE-MARKS—OPPOSITION—"LIGHTNING" AND DEVICE FOR DEMOUNTABLE WHEEL RIMS AND FOR AUTOMOBILE TIRES—DANGER OF CONFUSION.

Where opposer had registered for automobile tires a trade-mark consisting of the word "Lightning" and the device of a lightning flash, it would be damaged by the registration to applicant of a mark consisting essentially of the same word and a variation of the same device for demountable wheel rims, brake shoes and radiator shutters, as the public would be misled as to the source of the respective goods.

Trade-mark opposition and appeal from the decision of the Examiner of Interferences. Reversed.

Briesen & Schrenk, of New York City, for opposer.

Alfred T. Gage, of Washington, D. C., for applicant.

FENNING, A. C.: This is an appeal from the action of the Examiner of Interferences dismissing consolidated oppositions brought by the Carlisle Tire Corporation against two applications for registration of trade-marks by the Lightning Sales Corporation. One application consists of the word "Lightning", with the lower part of the L extended into what seems to be the simulation of a